



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-000x
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

460-010020-US (PAR)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 1/16/2006Signature *Lisa Shimizu*Typed or printed name Lisa Shimizu

Application Number

09/739,941

Filed

12/18/2000

First Named Inventor

Cofta

Art Unit

2136

Examiner

Parthasarathy, P.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 24,139☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Henry I. Steckler
SignatureHenry I. Steckler

Typed or printed name

(203) 259-1800

Telephone number

16 January 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PRE-APPEAL BRIEF REQUEST FOR REVIEW**1-Mistake of Law**

In section 11, on page 7, of the final rejection mailed November 3, 2005, the Examiner states that while specific portions of the reference are cited, the applicant is asked "...to fully consider the references in the entirety...". It is respectfully submitted that this is contrary to the USPTO rules, which state:

"When a reference is complex or shows or describes inventions other than that claimed by the applicant, the *particular part relied on must be designated as nearly as practicable*. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified"; see 37 C.F.R. 1.04(c)(2) (emphasis added) and EX parte Gambogi, 62 USPQ2d 1209, 1212. Thus applicants need only respond to designated parts of the cited reference since with fifteen drawing sheets and twenty-six columns of description it is undoubtedly complex.

2-Mistake of Fact

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shear.

The present invention provides an opportunity to identify and call functions or subroutines in software modules, not just based on subroutine name and parameter information, but also with an auxiliary tag. The method according to the invention makes it possible to simultaneously use two or more program modules, wherein the subroutines in the modules have the same name and parameter

information. This is not possible in prior art like C++ overloading. In addition, if the auxiliary tag is an encrypted digital signature, it can be used as an authentication that the program module is trusted. In this way, the main program can choose within all the possible program modules the one that it trusts. This is important especially when the modules are located in a network. The method for how modules are signed and by whom they are signed is not the scope of the present application.

Shear relates to secure execution environment where load modules are digitally signed by trusted authority and where module certification is verified by the execution environment before it is loaded. Shear mostly concentrates on the method of signing the load modules, and there are only a few general references as to how the actual loading is done. Column 6, lines 22-25, describes that signatures can be used to distinguish between load modules for different assurance levels, but Shear does not describe how this is achieved in detail.

The Examiner refers to Shear column 9, line 43-column 10, line 59, as the basis for the rejection of the present claim 1. This part of the text describes the process of signing the module and is not relevant because the present application does not describe how the signature to the module is formed but how it is verified during a module binding.

The Examiner also refers to column 20, line 1,-column 21, line 5. The first half of this part of the specification describes a certification of a module to

multiple assurance levels. Assurance level in Shear is a computing environment with certain "build-in" security features. For example, assurance level 1 can be a system where overall security is handled only with software. Assurance level 2 is a hybrid of software and hardware security techniques, etc. The certification to multiple assurance levels just means that load module is encrypted differently for different assurance levels. Again, this relates to signing the module and is not relevant to the present claim 1.

As Shear concentrates on signing the modules and describes the module loading process only on a general level, it cannot be considered as anticipating prior art. Specifically Shear does not teach that when binding the module, the program makes a call, provides the first tags and second call data, and the module to be bound is selected to be one which matches with the first tags and second call data transmitted in the call as recited in the claims.

The Examiner has traversed the above arguments again citing col.9, 1.43, to col.10, 1.59, and col.20, 1.1, to col.21, 1.5; and adding col.13, 1.4, to col.14, 1.60.

However, none of these sections expressly disclose the claimed making a call when binding the module, providing the first tags and second call data, and selecting the module to be bound which matches the first tags. It is noted that the CAFC has stated in Continental Can Co. USA Inc. v. Mousanto Co., 20 USPQ2d 1746, 1749:

"To serve as an anticipation when the reference is silent about the asserted inherent characteristics, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."

Here there is no showing that the missing claimed features are necessarily present or that it would be so recognized. Thus the rejection of claims 1-10 should be withdrawn.

The Examiner has argued that the process of providing a load module for verification, performing the verification, digitally signing the load module, and checking the digital signature can be read from the claim of the present invention. On page 1, of the present application the meaning of the word "binding" is clarified as follows (emphasis added):

"Binding refers in this specification to a process related to running of programs, in which a program component, such as a main program or a subroutine, calls another program component, such as a subroutine or a function. Binding can be further divided into so-called coarse-grain binding and fine-grain binding. In coarse-grain binding, a program module is selected, and in fine-grain binding, a subroutine, function or the like is selected from the program module."

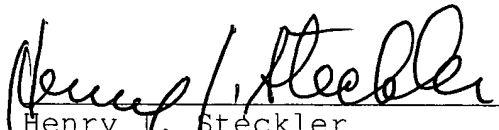
Shear does not teach anything which could be interpreted in the same way than the present claim 1 when the above cited meaning of *binding* is considered. A program component can not call a verifying authority because the verifying authority is not another program component. Further, claim 1 mentions that the binding is performed in a terminal. This can not be the case in Shear.

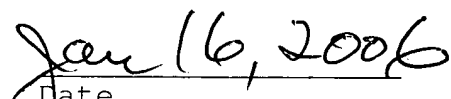
For this additional reason, the rejection of claims 1-10 should be withdrawn.

Further since the above discussed claimed features are not suggested by Shear, claims 1-10 are unobvious over it.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

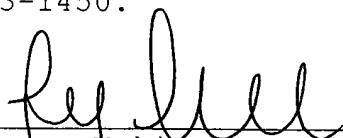

Henry J. Steckler
Reg. No. 24,139


Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 1/16/06Signature: 
Person Making Deposit